

REMARKS

FORMAL MATTERS

Claims 1-6, 14, 18, 24 and 29-42 are pending, with claims 1-6, 14 and 18 withdrawn from consideration as directed to non-elected subject matter. Claims 7-13, 15-17, 19-23 and 25-28 were previously canceled without prejudice against their reintroduction into this or one or more timely filed continuation, divisional or continuation-in-part applications. Thus, after entry of this Amendment, claims 24 and 29-42 are under consideration on the merits. The amendments to the claims and the various rejections raised in the Office Action are discussed in more detail below.

AMENDMENTS TO THE CLAIMS

By this Amendment, claim 24 is amended to recite that the claimed peptide "specifically binds to Texas Red fluorophore dye." Support for this amendment may be found throughout the specification, such as, for example on page 19, lines 9-16 and page 6, line 19 through page 7, line 5. No new matter is added by virtue of this amendment. Therefore, entry of the amendment is respectfully requested.

INTERVIEW SUMMARY

Applicants thank the Examiner for granting a telephonic interview regarding the above-referenced application on June 12, 2007. The participants were Examiner Shafiquel Haq (USPTO) and Gina Freschi (Applicants' representative). This written summary is submitted in accordance with MPEP § 713.04.

1. No exhibits were shown or discussed.
2. All pending claims were generally discussed.
3. Claim 24 was discussed specifically. Examiner Haq acknowledged that claim 24 is a generic claim. 37 CFR § 1.141 and MPEP § 809.02(a) were discussed, which state that upon allowance of a generic claim, Applicant is entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim.

4. Features were discussed which would limit the claim scope to those peptides enabled and reasonably encompassed by the generic claim.

ALLOWABLE SUBJECT MATTER

Applicants express gratitude for the Examiner's indication that claims directed to peptide of SEQ ID NO:15 are allowable.

However, as discussed in the interview of record, Applicants provisionally elected SEQ ID NO:15 for search purposes only, and with the understanding that this specific sequence was an *election of species*. Accordingly, once this species is found patentable, the Examiner is to then consider the patentability of other species within the scope of claim 24.

Claim 24 is generic to the elected and non-elected species, which are set forth in dependent claims 29-36. SEQ ID NOs:1 and 15-21 total less than ten and all contain exactly 12 amino acids. An alignment of the peptides (see Attachment 1) shows that a majority share at least about 80% sequence similarity. Further, all of these peptides share the common structural feature of binding specificity for Texas Red fluorophore dye, a structural feature now recited in generic claim 24. Applicants respectfully submit that there is minimal additional burden on the Examiner to search seven sequences, a number that has been determined to constitute a reasonable number for examination purposes under MPEP § 803.04, and particularly in light of the fact that SEQ ID NO:15 was previously searched and determined to constitute patentable subject matter in Applicants' parent case, Application Serial No. 09/419,381, filed October 15, 1999, now U.S. Patent No. 6,747,135.

Accordingly, as discussed in the telephonic interview of June 12, 2007, Applicants respectfully request that the Examiner continue searching the additional species falling within the genus of claim 24, which are enumerated in dependent claims 29-36.

RESTRICTION REQUIREMENT

In the Office Action, the Examiner requests Applicant to cancel all claims to non-elected subject matter. However, Applicants assert the need to keep claims to non-elected species pending in order to preserve the right to rejoinder. Specifically, Applicants seek to keep method claims 40 through 42 pending in "withdrawn" status to preserve the right to rejoinder of method

claims to an allowed product claim, from which they depend (*see* MPEP § 821.04 "when all the claims directed to the elected invention are in condition for allowance ... the nonelected invention(s) should be considered for rejoinder").

OBJECTIONS TO THE CLAIMS

Claim 24 is objected to for allegedly containing non-elected subject matter. As set forth above and in the interview summary, Applicants respectfully assert the right to maintain claim 24 in generic form, and request that the Examiner continue searching the enumerated additional species falling within the genus of claim 24, which are set forth in dependent claims 29-36.

REJECTIONS UNDER §112, ¶1

The Examiner contends that claims 39, 40, 41 and 42 are not enabled under 35 U.S.C. 112, first paragraph, stating that while the specification is enabling for binding of the peptides to Texas Red dye, it does not enable binding of the peptides of claim 24 to all fluorophore dyes. This rejection is addressed by amendment and may be withdrawn.

DOUBLE PATENTING

Claims 38-42 were rejected under the judicially-created, non-statutory obvious type double patenting doctrine as allegedly unpatentable over claims 1, 3-4, 7 and 10 of U.S. Patent No. 6,747,135. A Terminal Disclaimer prepared in accordance with 37 C.F.R. § 1.32(b) and (c) is enclosed. The signed Terminal Disclaimer obviates the rejection and withdrawal is respectfully requested.

CONCLUSION

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number STAN-426CON.

Respectfully submitted,
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Enclosure(s): Attachment 1 – Peptide alignment

Terminal Disclaimer Over U.S. Patent No. 6,747,135

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Attachment 1

AMAP (2.0) multiple sequence alignment

SEQIDNO15	KPVQYWTQMFYT	12
SEQIDNO1	KHVQYWTQMFYS	12
SEQIDNO16	KPAQYWTQMFYS	12
SEQIDNO17	KNVQYWTQMFYT	12
SEQIDNO18	KHVQYWTHMFYT	12
SEQIDNO19	KHVQYWTQMFYT	12
SEQIDNO20	NHVHYWTQMFYS	12
SEQIDNO21	THVQYWTQMFYS	12
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